DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/27/2009 has been entered.

Response to Amendment

2. This office action is in response to amendment /reconsideration filed on 04/27/2009, the amendment/reconsideration has been considered. Claims 1, 9, 14-16 and 23-25 has been amended, claim 30 have been newly added and therefore, claims 1-4, 6-11, 13-19, 21-27 and 29-30 are pending for examination, the rejection cited as stated below.

Response to Arguments

3. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim(s) 1 and 9, are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claims method including steps of receiving, prompting, determining, indicating to *users* rather than machines and are broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. For example a "session" may be interpreted as a meeting and the users sending and receiving messages does not require any machine form and can be done verbally.

6. As to claims 14, 23, the language of the claim raises a question whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical operation producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. In particular, the language of the claim directed to a program per se claim (Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, 1760).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15 and 24, are rejected under 35 U.S.C 112 second paragraph as there is no corresponding structure in the specification as how and what these "means for" limitations accomplished. It is further noted the means plus function limitation that invokes 35 U.S.C 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material or acts perform the claimed function.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-4, 6-11, 13-19, 21-27, 29 and 30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Couts et al. (Pub. No. US 2003/0120805 A1), hereinafter "Couts" in view of Morris et al. (Patent No.: SU 6496,851 B1), hereinafter "Morris and further in view of Danieli et al. (Pub. No.: US 2005/0181878 A1), hereinafter "Danieli".

11. As to claims 1,9, 14-16, 23-25, Couts discloses the invention substantially, including, receiving an instant messaging (IM) message from a first user to a second user ([0024, lines 2-4], where communication message is inherently an instant message and [0013, lines 12-13], where interactive communication is conducted in real time, Fig.2, Step-204, recipient and Fig.1, Step-102-108, senders and receivers);

prompting the first user for permission to convey the IM message to a third user ([0038, lines 14-19] and [0027, lines 5-13]);

determining whether the second user is currently engaged in an IM chat session with a fourth user (Couts, Abstract, where determination is made through presence and available status, where available user can be second, third or fourth).

Couts however, is silent on indicating to the first user, that the second user is engaged in an IM chat session with the fourth user. Morris however discloses, indicating to the first user (Morris, Fig.13, Co1.12, lines 37-43, where popup window is the indication of response from the second party that proposal has been rejected), that the second user is engaged in an IM chat session with the fourth user (Morris, Fig.13, element-1300, lines 37-43, where message displays as user has declined your chat invitation, where user can be third, fourth etc. and invitation can be due to various reasons e.g. busy, offline or not interested in proposal).

Morris further discloses, prompting the user to join the IM chat session (Morris, Fig.2, Col.2, lines 30-35, If a participant desires some privacy, that participant may open and enter a "private" chat room (for example, by clicking on a "Private Room" button 212), and thereafter invite one or more other participants to enter the private chat room, which can be accessed exclusively by the originators and their invitees).

Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of Couts with the teachings of Morris in order to provide an instant messaging graphical user interface architecture and a protocol used in a chat room environment which allows users to transmit messages to each other, referred to as "Evil" messages, registering displeasure with any proposal, counterproposal, or acceptance, where an Evil message has a cumulative (and

potentially exponential) effect upon a recipient's ability to access the computer system's resources.

Couts and Morris however are silent on disclosing explicitly, in response to receiving an indication that the first user wants to join the IM chat session, prompt the second user to allow the first user to join the IM chat session; and

in response to receiving an indication that the second user wants to allow the first user to joint the IM chat session, facilitate joining of the first user to the IM chat session.

Danieli however discloses a similar concept in online gaming/chatting environment e.g. prompting the first user to join the IM chat session and in response to receiving an indication that the first user wants to join the IM chat session, prompt the second user to allow the first user to join the IM chat session and in response to receiving an indication that the second user wants to allow the first user to joint the IM chat session, facilitate joining of the first user to the IM chat session (Danieli, [0062], For example, of the three players (Burt, Don, and Chuck) invited by Adam in the foregoing example, Burt is the only contact that has an MSN messenger availability status of "online," and a gaming utility availability status icon 55 indicating that Burt is running an instance of gaming utility 30. This status icon means that Burt is presently logged on to Internet 10 and MSN messenger, is running the gaming utility, and has not selected an availability status that indicates he is unavailable. Accordingly, a modal dialog (not shown) will pop up on Burt's PC 13 displaying an invitation message reading "Adam invites you to join Adam's chat," with accept and decline button options.

Therefore it would have been obvious to one of the ordinary skilled in the art at the time the invention was made to combine the teachings of Couts and Morris with the teachings of Danieli in order to provide a easy way for players to host and join new instances of multiplayer online electronic games, as well as providing a scheme that enables players to join games that are already in progress. The method is implemented through a gaming utility that runs on each of the player's electronic devices (e.g., personal computers (PCs)) and interacts behind the scenes with an online messaging service.

12. As to claims 2 and 17, Couts, Morris and Danieli discloses the invention substantially as in parent claims 1 and 16, including, receiving an input from the first user (Couts, [0024, lines 2-4], where communication message is inherently an instant message which can also be an input), the input being indicative of the permission to convey the IM message to the third user (Couts, Abstract, where forwarding list or buddy list is obviously has the permission by default to have the messages forwarded to any user in the forwarding list); and

conveying the IM message to the third user in response to receiving the input (Couts, Abstract, where message is forwarded to next person listed on the forwarding list).

13. As to claim 3, 10, 18 and 26, Couts, Morris and Danieli discloses the invention substantially as in parent claims 2,9,17 and 25, including, indicating to the first user that the IM message is being conveyed to the third user (Morris, [0041, lines 1-13], where

communication message is inherently an instant message and [0013, lines 12-13], where interactive communication is conducted in real time and where response to sender's message itself is a delivery confirmation of a message).

14. As to claim 4, 11, 19 and 27, Couts, Morris and Danieli discloses the invention substantially as in parent claim 2,9,16 and 25, including, indicating to the third user that the IM message originated from the first user (Morris, Fig.12, element-1200, where subject of the message indicates the origin of the message which can be a third or any other user).

15. As to claims 6 and 21, Couts, Morris and Danieli discloses the invention substantially as in parent claims 1 and 16, including, waiting a predefined time interval prior to requesting prompting the first user for permission (Couts, Abstract, Where forwarding list is a prompting for permission and obviously there is criteria set for forwarding if the user is not available arguably, where predefined time could be null).

16. As to claims 7 and 22, Couts, Morris and Danieli discloses the invention substantially as in parent claim 6, including, a second user as unavailable, in the absence of a response from the second user during the predefined time interval, that the second user is unavailable (Morris, Fig.13, Col.7, lines 18-30, where response can indicate in manners described as "online but not available/busy and further modification will be obvious to one of ordinary skilled in the art).

17. As to claim 8, Couts, Morris and Danieli discloses the invention substantially as in parent claim 6, including, wherein requesting permission from the first user is responsive to an absence of an input from the second user during the predefined time interval (Morris, Fig.13, Col.7, lines 18-30, where response can indicate in manners described as "online but not available/busy and therefore, message can be forwarded to another device or user and further modification will be obvious to one of ordinary skilled in the art).

18. As to claims 13 and 29, Couts, Morris and Danieli discloses the invention substantially as in parent claims 6 and 25, including, further indicating to the first user, in response to determining that the first recipient is engaged in an IM chat session with a fourth user, that an IM chat session is being established between the first user and the third user (Morris, Fig.13, Col.7, lines 18-30, where response can indicate in manners described as "online but not available/busy and therefore, message can be forwarded to another device or user, if proposal gets accepted by a user the response will be generated as discloses in Col.3, lines 64-67 and further modification will be obvious to one of ordinary skilled in the art).

19. Claim 30 is rejected under for same rationale as applied to claim 25 above.

Allowable Subject Matter

20. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Danieli et al. US 7240093 B1.

Wen et al. US 7181492 B2

Pennock et al. US 6807562 B1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAUQIR HUSSAIN whose telephone number is (571)270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571 272 3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. H./
Examiner, Art Unit 2452

/Dohm Chankong/
Primary Examiner, AU 2452